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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,205	12/12/2000	Kaoru Okuno	50212-174	1983
20277	7590	10/15/2003	EXAMINER	
MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/734,205	Applicant(s) OKUNO ET AL.	
	Examiner John Hoffmann	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The spacing of the words of the specification is such as to make reading and entry of amendments difficult. For example, see lines 17-18 of page 1: there is essentially no spacing between the words.

New application papers with readable spacing on good quality paper are required.

Claim Rejections - 35 USC § 103

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roba 6371394.

The paragraph spanning cols. 6-7 discloses the use of the furnace of 5114338 or 4969941 - each of which have a furnace core tube. It would have been obvious to insert the Roba preform (see Roba fig 1) into the tube, than to build the tube around the preform, because it would be easier to insert the preform.

The step of heating and the step of drawing are clearly shown in figure 1 and are elsewhere described in Roba.

The tension measuring step is disclosed at col. 8, lines 29-35.

A heat changing step is present: see col. 7, lines 4-7 and 37-40. The change of heat is not dependant solely on the main heater: col 7, lines 37-40.

As to the heat changing being "in response to the measured glass draw tension". Roba doesn't explicitly mention this. However, col. 9, lines 28-34 discloses controlling the process "on the basis of the values of pre-set **process parameter** values and on the basis of the signals" from the sensors "along the tower". Tension is a signal from a sensor along the tower, see col. 8, lines 29-35. There is no indication of any process parameter values which are "pre-set"; however col. 7, line 5 identifies the furnace temperature (and thus heat) is a **process parameter** which is controlled. It is deemed that the passage at col. 9, lines 28-34 sets forth that any of the disclosed **process parameters** could use pre-set values: since Roba only mentions a few **process parameters** it is deemed that any discussion of **process parameters** encompasses at least each of the specific **process parameters** mentioned by Roba.

The local chromatic dispersion is inherently changed. It is noted that the limitation "to change....." is merely an intended use function which does not limit the manipulative steps. Having an intention to change a tension to a predetermined value - does not require actually changing to the predetermined value.

In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The limitation "to change the measured glass draw tension..." is simply an intention with no manipulative difference; the claim does not require that the tension actually reach a predetermined value.

Response to Arguments

Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection.

Applicant remarks that claim 1 incorporates the limitations of claim 6 (which was not previously rejected, nor identified by Applicant to read on the elected species as required in the Paper of 4/22/03). This is not a precise statement because Claim 1 incorporates **additional** limitations - namely that the change in heat be in response to the measured tension. Original claim 6 only further required that the tension be measured - and this is clearly evident in figure 4 of Clayton. The adjusting of heat was already required in claim 1. The intention of "so that the measured draw tension will become a predetermined value - does not give any manipulative difference: there is no requirement that the tension actually becomes the predetermined value.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

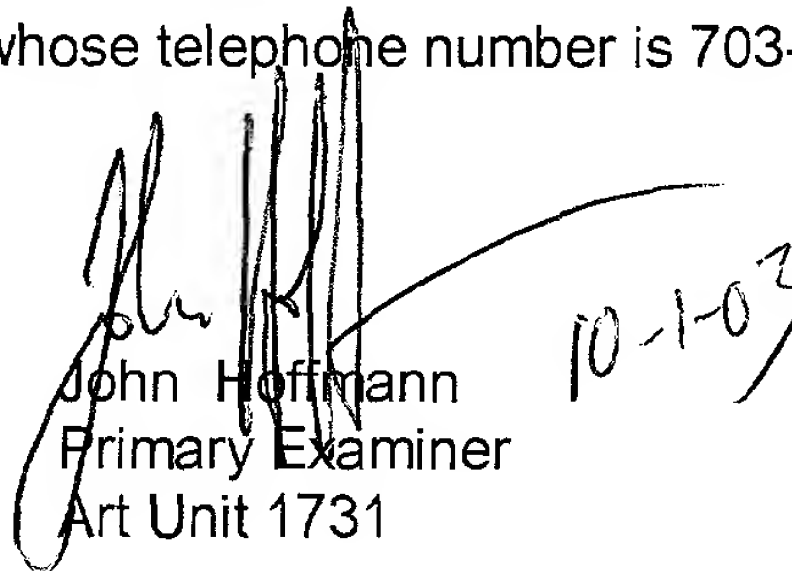
Art Unit: 1731

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


John Hoffmann
Primary Examiner
Art Unit 1731
10-1-03

jmh